

II. **Rejection Under 35 U.S.C. § 102(b)**

The Examiner has maintained the rejection of claims 49-59, 61, 65-78, 82-84, 86-88, and 92-98 under 35 U.S.C. § 102(b) as anticipated by U.S. Pat. No. 4,655,836 to Drawert et al. ("Drawert"). See pages 2-4 of the present Office Action. Applicants respectfully traverse this rejection.

For a reference to anticipate the pending claims, it must teach, either expressly or inherently, each and every claimed element. M.P.E.P. § 2131; *PIN/NIP, Inc., v. Platte Chem. Co.*, 304 F.3d 1235, 1243 (Fed. Cir. 2002). In the present case, *Drawert* fails to teach, expressly or inherently, each and every claim limitation.

First, *Drawert* fails to teach a structured nail polish composition. Although the Examiner asserts that this limitation of the present claims is satisfied because "both the compositions [of *Drawert* and of the presently claimed invention] are drawn to coating[s]," Applicants respectfully disagree.

The preamble of a claim limits the claim if it "breathes life and meaning into the claim." M.P.E.P. § 2111.02. In order to limit the claim, the preamble must be "essential to point out the invention defined by the claim." *Id.*; see also *Kropa v. Robie*, 187 F.2d 150, 152, 88 U.S.P.Q. 478, 481 (CCPA 1981).

In *Kropa*, the Federal Circuit held that a preamble reciting "an abrasive article" was essential to point out that the invention defined by the claims was an article comprising abrasive grains and a hardened binder and the process of making it. The Court said that "it is only by that phrase that it can be known that the subject matter defined by the claims is comprised as an abrasive article. **Every union of substances capable *inter alia* of use as abrasive grains and a binder is not an 'abrasive**

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article.'" *Id.* (emphasis added). Thus, *Kropa* stands for the proposition that, where the preamble serves to further define the structure of the article produced, the preamble should be given patentable weight.

In the present case, as in *Kropa*, the recitation of "a structured nail polish composition" is essential to point out that the invention defined by the claims is directed to a structured composition for application to human nails. Like *Kropa*, not every union of substances capable, *inter alia*, of use as a coating is a "structured nail polish composition." For example, the coatings in *Drawert* may not be suitable for application to nails because of the nature and/or the concentrations of various ingredients (e.g., gasoline in examples 11-16 and 22) and/or because of processing requirements (e.g., see col. 1, lines 37-40 discussing a "fully cured coating film"). Moreover, *Drawert's* compositions are clearly not intended for application to nails. See e.g., col. 4, lines 20-26, reciting suitable substrates which do not include nails.

Accordingly, the recitation that the presently claimed composition is a "structured nail polish composition" serves to further define the inventive composition and cannot be ignored under the Federal Circuit holding in *Kropa*. Moreover, the present claims are clearly limited in the body of the claim to structured nail polish compositions. *Drawert* does not teach or suggest nail polish compositions and therefore cannot anticipate the present claims for at least this additional reason.

Second, the present claims recite at least one first polymer comprising, *inter alia*, at least one fatty chain containing from 6 to 120 carbon atoms and chosen from at least one pendent fatty chain and at least one terminal fatty chain, wherein the at least one fatty chain is linked to the hydrocarbon-based units and is optionally functionalized.

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Whether a genus anticipates a subgenus or a species depends on both the size of the disclosed genus and the disclosure of preferred sub-genera and/or species, if any. A genus may anticipate a subgenus or a species where the disclosed genus is sufficiently limited and defined. See e.g., *In re Petering*, 301 F.2d 676, 682, 133 U.S.P.Q. 275, 280 (C.C.P.A. 1962), *In re Meyer*, 599 F.2d 1026, 1031, 202 U.S.P.Q. 175, 179 (C.C.P.A. 1979) (finding that prior art genus did not "identically disclose or describe, within the meaning of section 102 [the claimed species] since the genus would include an untold number of species"). A generic formula will anticipate a claimed species or sub-genus covered by the formula when the species can be "at once envisaged" from the formula. See M.P.E.P. § 2131.02. One may look to the preferred embodiments to determine which compounds can be anticipated. *Id.*

In the present case, as in *Meyer*, *Drawert* discloses a broad genus of "antislip additives . . . prepared by condensation of a polymerized fatty acid with a diprimary ether diamine, optionally with the concurrent use of a co-diamine." See e.g., col. 1, line 67 through col. 3, line 8. This broad genus would comprise an untold number of species. Moreover, *Drawert* is silent with respect to pendent and terminal fatty chains on the dimeric fatty acid, and recites that the R group in the diprimary ether diamines may be "an aliphatic hydrocarbon having from 2 to 6 carbon atoms in the main chain, optionally substituted by **short-chain** alkyl groups, and more particularly by methyl." See col. 2, line 67 through col. 3, line 2 (emphasis added). In fact, not one of the polymers or components of polymers disclosed in either the specification (e.g., col. 2, lines 51-64 and col. 3, lines 3-6) or any of the multiple examples comprises at least one fatty chain

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containing from 6 to 120 carbon atoms and chosen from at least one pendent fatty chain and at least one terminal fatty chain.

Accordingly, the disclosed genus in *Drawert* comprises an untold number of species and is not sufficiently limited and defined to anticipate the presently claimed sub-genus. Further, no species of the presently claimed sub-genus can be "at once envisaged" from *Drawert's* specification, preferred embodiments, or examples, nor has the Examiner pointed to any reason why Applicants' sub-genus would be, as she must to satisfy her burden under 35 U.S.C. § 102(b). For at least these reasons, *Drawert* fails to anticipate the presently claimed sub-genus of polymers.

Finally, nowhere does *Drawert* teach or suggest that its antislip additives structure a liquid organic phase, or that the compositions disclosed therein are structured. Accordingly, *Drawert* does not anticipate the present claims for at least this additional reason.

For at least the foregoing reasons, Applicants respectfully request withdrawal of this rejection.

### III. Rejection Under 35 U.S.C. § 103

The Examiner has maintained the rejection of claims 49-105 under 35 U.S.C. § 103 as obvious over U.K. Patent Application No. 2,196,978 to Plough ("Plough") in view of U.S. Patent No. 6,402,408 to Ferrari ("Ferrari"). Applicants respectfully traverse this rejection.

The Examiner asserts that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to prepare compositions of [Plough] and

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combine it [sic] with the polymer of [*Ferrari*]." See page 6 of the present Office Action. Applicants disagree.

Two of the basic criteria an Examiner must demonstrate in order to establish a *prima facie* case of obviousness are (1) that there is some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings, and (2) that there is a reasonable expectation of success in making the proposed modification. See M.P.E.P. § 2143. Neither of these two criteria has been satisfied with respect to the combination of *Plough* with *Ferrari* proposed by the Examiner.

With respect to the first criterion, the Federal Circuit has recently stated that:

[t]he factual inquiry whether to combine references must be thorough and searching. It **must be based on objective evidence of record....** Thus the Board must not only assure that the requisite findings are made, based on evidence of record, **but must also explain the reasoning by which the findings are deemed to support the agency's conclusion.**

See *In re Lee*, 61 U.S.P.Q.2D (BNA) 1430 (Fed. Cir. 2002) (emphasis added). Moreover, the mere fact that references **can** be combined or modified does not render the resultant combination obvious unless the references **also suggests the desirability** of the combination. See M.P.E.P. § 2143.01 (emphasis added).

In the present case, the references cited by the Examiner fail to suggest the desirability of the proposed combination. In fact, *Plough teaches away* from the proposed combination. The Federal Circuit has held a prior art reference must be considered in its entirety, and one may not "disregard[] disclosures in the references that diverge from and teach away from the invention at hand." *W.L. Gore & Assocs., Inc., v. Garlock, Inc.*, 721 F.2d 1540, 1550 (Fed. Cir. 1983). Thus, the Examiner must

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consider the entire disclosure of Plough, including those portions that teach away from the proposed combination. See *In re Kotzab*, 217 F.3d 1365, 1370 (Fed. Cir. 2000) ("a rejection cannot be predicated on mere identification in [a prior art reference] of individual components of claimed limitations").

In the present case, the compositions of *Ferrari* comprise "at least one liquid fatty phase **structured** with at least one structuring polymer...." See Abstract. "[S]tructured" means **gelled and/or rigidified.**" See col. 1, line 15. The compositions of *Ferrari* may be, *inter alia*, in the form of a **rigid structure** in the form of a **tube or a stick**, or can be a disintegrable **solid which does not flow under its own weight**. See e.g., col. 1, line 55, col. 5, lines 19-20, lines 27-28, and lines 54-59.

In contrast, *Plough* is drawn to "a cosmetic composition for strengthening nails comprising an amount of glyoxal effective for strengthening nails in a substantially non-aqueous conventional nitrocellulose-based nail lacquer preparation." See page 1, lines 44-46. *Plough* teaches that "[n]itrocellulose is the primary film-former used in the typical lacquer preparation and should have a viscosity value (R/S Value) of from 1/4 to 5/6 (enabling the manufacture of cosmetic nail strengthening compositions that **flow readily....**)" See page 2, lines 34-36 (emphasis added). Accordingly, the process in *Plough* "consists of strengthening finger or toe nails, by applying to the surface thereof **using a convention nail polish applicator**, a cosmetic composition such as described above or in the examples" See page 3, lines 22-24 (emphasis added). The compositions of the examples are "**fill[ed] into bottles.**" See page 4, line 4 (emphasis added).

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Accordingly, one of ordinary skill in the art would not have been motivated to add the structuring polymer of *Ferrari* which gels and/or rigidifies a liquid fatty phase to the compositions of *Plough* which are intended to flow readily and be used with a conventional nail polish applicator, i.e., a bottle and a brush. Such a modification to the composition of *Plough* would serve to destroy the stated purpose of the compositions. Similarly, for at least this reason, one of ordinary skill in the art also would not have had a reasonable expectation of success in making the proposed combination.

Furthermore, the Examiner's asserts that "[*Plough*] teaches that secondary resins compatible with nitrocellulose are 'Versamid'." See page 6 of the present Office Action. Applicants note, however, that while Versamid 930 from Henkel, Inc. is disclosed as a suitable secondary resin in *Plough*, *Ferrari* **teaches away** from such polymers, including particularly Versamid 930. See Counter Example at col. 10, lines 51-59. Specifically, *Ferrari* teaches that when

[t]he lip composition of Example 1 was repeated, replacing the Uniclear 80 polyamide with the Versamid® 930 polyamide sold by Henkel, and then by Macromelt® 6212..., these two polyamides being free of an end group with an alkyl or alkenyl chain containing at least 4 carbon atoms, linked to the polyamide skeleton via an ester group...[, t]he products obtained were totally heterogeneous and in two-phase form. They did not in any way have the appearance or hardness of a stick.

*Id.*

Finally, for the record, Applicants wish to address the Examiner's assertion that "[n]on-migration would imply to the nail art as quick drying time." See page 7 of the present Office Action. Applicants note that **nowhere** does *Ferrari* support this interpretation nor is it consistent with its plain meaning. As the Examiner is aware, "[w]hen not defined by applicant in the specification, the words of a claim must be given

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their plain meaning." M.P.E.P. § 2111.01. However, *Ferrari* itself makes clear that migration refers to a running of the composition, especially of the liquid fatty phase, into wrinkles and fine lines on the skin or lip after the initial application of the composition. See e.g., col. 1, lines 32-40, col. 6, lines 6-9, and Example 1. Nowhere does *Ferrari* teach or suggest that non-migration as defined therein would even apply to nail polishing compositions let alone that it could be interpolated as "quick drying time," as the Examiner states.

For at least the foregoing reasons, Applicants assert that one of ordinary skill in the art would not have been motivated to make the proposed combination nor have had a reasonable expectation of success in doing so. Accordingly, Applicants respectfully submit that the Examiner has failed to establish a prima facie case of obviousness, and thus, request that the rejections under 35 U.S.C. § 103(a) be withdrawn.

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IV. Conclusion

In view of the foregoing remarks, Applicants respectfully request the reconsideration and reexamination of this application and the timely allowance of the pending claims.

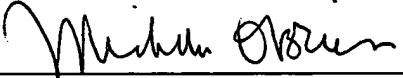
Please grant any extensions of time required to enter this response and charge any additional required fees to Deposit Account No. 06-0916.

Respectfully submitted,

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